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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,892	12/14/2000	Takayuki Yamamoto	Q62230	5759

7590 05/04/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 9/4/03 and 2/20/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2, 5 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2, 5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 2 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, applicants' RCE application appears to have both entered the after final rejection amendment (which was proposed but not entered in the Advisory Action mailed February 20, 2004, Paper No. 021204) as well as the most recent amendment filed March 2, 2004, with the resultant effect being that the pending claims contain a significant number of serious informalities.

Accordingly, the Examiner proposes revising applicants' latest submitted claim 5 with the claim 5 which was previously presented in the application set forth in the response filed June 26, 2003.

It is further noted that the presently pending independent claim 5 filed contains both the vague, indefinite and confusing term "final" polymer (which may wll also be be new matter) and the Examiner also notes the presence of an apparent typographical error which has crept in in line 5 of claim 5 wherein it is stated that there is "a molecular weight of 105 or lower", instead of what is clearly proper, --a molecular weight of 10^5 or lower--. Accordingly, it is strongly suggested that the

following claim be used in place of claim 5:

--A semiconductor wafer processing method, comprising adhering a removable pressure-sensitive adhesive sheet which comprises a pressure-sensitive adhesive layer which is made of at least a pressure-sensitive adhesive comprising a polymer in which the content of low-molecular components having a molecular weight of 10^5 or lower is 10% by weight or lower, and the polymer has a weight average molecular weight of 930,000 to 2,100,000, to a front or back surface of the wafer, and processing the wafer.--
Additionally, in claim 2, it is strongly suggested to delete in line 1 the word "final".

3. The following is a quotation of the first paragraph of

35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2 and 5 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. More particularly, the incorporation into both claims 5 and 2 of the word "final" to characterize "polymer" is believed, as was noted above, to be new matter since no express support for such term exists, and the Examiner does not believe any inherent support also exists (it is not believed any polymer is "final").

5. Claims 2 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -470 taken in view of applicants' admissions in the specification regarding the usage of pressure sensitive adhesive sheets in semiconductor processing operations as set forth on page 1 and extending to page 2, line 7 of the specification, substantially for reasons of record, together with the following additional observations. To reiterate, the Examiner believes that the claimed weight average molecular weight range of 930,000 to 2,100,000 is believed to at the very least intersect with the preferred number average MW range of 100,000 to 500,000 taught (page 7, line 6) by EP -470. In support of the Examiner's position note again as evidence of the state of the art, Chapter IV, pages 49-53 of "Organic Coatings: Science and Technology", Volume 1, 1992, particularly at page 51, the last complete paragraph. In particular, note the teaching wherein the 2/1 minimum theoretical relationship taught as existing between the two MW ranges leads to the clear conclusion

that at least the upper range taught by the reference clearly overlaps with at least the lower part of applicants' claimed range. Note also that this rationale has been relied upon in the instant application for several Office actions, and applicants have failed to overcome its logic, which is hereby repeated. As such, applicants' newly presented arguments (Response, paragraph bridging pages 4-5) wherein an alleged distinction between "final" or "post-reaction polymers" versus the alleged EP -470 disclosure of "pre-reaction" acrylic polymers of a certain molecular range is, it is respectfully submitted, not found to be convincing.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

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obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

April 26, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker